

REMARKS

Claims 2-6 and 8-19 are now pending in the application. Claims 1 and 7 have been cancelled. Claim 19 has been added as new. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 2, 3, 5, 6, 8, and 10-18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesher et al. (U.S. Pat. No. 4,604,933, hereinafter "Lesher") in view of Mattes (U.S. Pat. No. 4,137,808, hereinafter "Mattes"), and further in view of Kullmann et al. (U.S. Pat. No. 5,425,296, hereinafter "Kullman"). This rejection is respectfully traversed.

Claims 4 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lesher in view of Morris et al. (U.S. Publ. No. 2002/0194974, hereinafter "Morris"). This rejection is respectfully traversed.

Claims 13 and 14

At the outset, Applicants note that there is no motivation for the combination of references cited by the Examiner. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992)(citing In re Gordon, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). In the present Office Action, the Examiner does not cite any motivation for his combination of Lesher, Mattes, and

Kullman. The Examiner merely states that “[i]t would have been obvious to have modified Lesher to incorporate the teachings of Mattes and Kullman.”

The MPEP specifically disallows reliance on conclusory statements. “The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.” MPEP §2144.03(A) (citing In re Lee, 277 F.3d 1338). The Examiner’s argument that “[i]t would have been obvious” to combine the cited references is conclusory. As the MPEP explicitly disallows the use of conclusory statements when combining prior art references, the Examiner’s argument is inappropriate.

Rather than suggesting the combination, the references actually appear to teach away from the combination cited by the Examiner. It is established that where references, instead of suggesting the invention, seek or warn to avoid the suggestion, such references diverge from and teach away from the invention at hand and it is error to find obviousness based on such references. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1599 (Fed. Cir. 1988)(citing W.L. Gore & Assocs. v. Garlock, Inc., 721 F.2d 1540, 1550, 220 USPQ2d 303, 311 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). With regard to the combination proposed by the Examiner, the disclosure of Mattes is not in agreement with the disclosures of Lesher and Kullman.

Specifically, Lesher clearly states that “all teeth 8, 9 as well as the blade body 5 are symmetrical to a plane that is normal to the saw axis.” (col. 5, lines 23-24). Kullman similarly states that “[t]he design of each tooth 2 is designed symmetrically with respect to the longitudinal center plane 8, so that the phases 7 are provided symmetrically to the right and left of each tooth.” (col. 7, lines 16-19). Conversely,

Mattes teaches non-symmetric teeth. Any modification of the teeth in Lesher and Kullman, as suggested by the Examiner, would teach away from the symmetric tooth structure set forth in the specifications of both Lesher and Kullman and would therefore be inappropriate in view of the precedent discussed above.

As the combination of the references teaches away from the claims of the present application, the Examiner appears to be merely picking and choosing elements from each of the references to construct his rejection. "Virtually all inventions are necessarily combinations of old elements. The notion, therefore, that combination claims can be declared invalid merely upon finding similar elements in separate prior art patents would necessarily destroy virtually all patents and cannot be the law under the statute, Section 103." Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1575, 1 USPQ2d 1593, 1603 (Fed. Cir. 1987). In the present rejection the Examiner appears to be ignoring structure required in the specification of each of Lesher, Mattes, and Kullman and merely combining individual elements picked from each of the references. As indicated above, this type of combination of references is inappropriate. When the references are each viewed in their entirety, they cannot be seen as teaching the limitations of claims 13 and 14.

As such, Applicants respectfully submit that claims 13 and 14 are in condition for allowance. Claims 2-6 and 15-17 depend from claim 13 and claims 8-12 and 18 depend from claim 14, and therefore should be in condition for allowance for the reasons set forth above. Therefore, reconsideration and withdrawal of the rejection of claims 2-6 and 8-18 are respectfully requested.

Claim 2

In addition to the reasons set forth above regarding claim 13, Applicants submit that claim 2 is also not taught by the combination of Lesher, Mattes, and Kullman. Specifically, the Examiner states that “Lesher further teaches the interface of adjacent inserts being closer to alternate sides of the annular body.” The Examiner does not cite any specific support in for this proposition in Lesher. Upon review of Lesher, Applicants are unable to find any support for this proposition as well. It does not appear possible for Lesher to support this proposition, as the claimed interface is not present in Lesher. The claimed interface is defined as the interface between the first edge surface, which extends generally parallel to the axis of rotation and extends to the first side of the insert, and the second edge surface.

The teachings of Mattes fail to disclose the features of claim 2 as well. As seen in Figures 4 and 5 of Mattes, if the junction of faces 10 and 14 in Figure 4 and the junction of faces 10a and 15 were considered the “interfaces” of claim 2, Mattes would teach away from the claimed limitations. The portions that might be considered “interfaces” in Mattes are located on alternating teeth, but are located closer to the same side for each of the alternating teeth. As such, even if the Examiner were to construe Lesher as teaching the limitations of claim 2 in some way, the teachings of Mattes, which are used in combination with Lesher by the Examiner would still teach away from the modification.

As such, Applicants respectfully submit that claim 2 is in condition for allowance for the reasons set forth above in addition to the reasons set forth regarding claim 13.

NEW CLAIMS

Claim 19 has been added as new. Claim 19 is supported by the specification and drawings as originally filed, and therefore does not constitute new matter. Claim 19 depends from claim 13 and should be in condition for allowance for the reasons set forth above.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

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